

**Remarks**

Claims 16-29 are pending in the application and stand rejected. Claims 16, 17, 22, and 23 are amended in the present Response to recite an “epothilone, wherein the epothilone comprises a 16-membered ring with an epoxide at C12-C13”. Support for this amendment can be found throughout the application in that many of the epothilones in the application include a 16-membered ring with an epoxide at C12-C13. Applicant, therefore, submits that no new matter is added by the present Amendment. Applicant respectfully requests reexamination and reconsideration of the present case, as amended. Each of the rejections levied in the Office Action is addressed individually below.

**I. Rejection under 35 U.S.C. § 103.** Claims 16-29 have been rejected by the Examiner under 35 U.S.C. § 103 as being unpatentable over Bollag *et al.*, *Cancer Res.* 55:2325-2333, 1995. The Examiner maintains that “claiming variable effective amounts of the epothilones, and administration of the effective doses to a subject multiple times is not in and of itself patentable over the prior art of Bollag *et al.*” Applicant disagrees. In addition to dosages, the claimed invention includes a glycol, oil, or alcohol as a pharmaceutically acceptable excipient. Bollag *et al.* does not teach or suggest these excipients. Therefore, the claims are not rendered obvious by Bollag *et al.* Applicant requests that the rejection be removed.

**II. Double Patenting Rejection.** Claims 16-29 have been rejected by the Examiner under the judicially created doctrine of double patenting over claims 1-14 of U.S. Patent 6,828,340 (the ‘340 patent). Applicant submits herewith a terminal disclaimer. The terminal disclaimer disclaims any portion of the term of a patent that issues from this application that extends beyond the ‘340 patent. Applicant submits that the terminal disclaimer submitted herewith removes any basis for an obviousness-type double patenting rejection based on the ‘340 patent.

In light of the foregoing Amendments and Remarks, Applicant respectfully submits that the present application is in condition for allowance; a Notice to that effect is respectfully requested.

If it is believed that a telephone conversation would expedite matters, the Examiner is invited to contact the undersigned at (617) 248-5215. The Examiner is authorized to charge any fees associated with this amendment, or to refund for any overpayment, to our Deposit Account Number 03-1721.

Respectfully submitted,

  
C. Hunter Baker, M.D., Ph.D.  
Registration Number 46,533

Choate, Hall & Stewart LLP  
Two International Place  
Boston, MA 02110  
(617) 248-5215  
(617) 248-4000 (fax)  
chb@choate.com  
Date: September 21, 2005

**Certificate of Mailing**  
I certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 145 Alexandria, VA 22313-1450.

September 21, 2005   
Date Signature  
Kenneth R. Maben  
Typed or Printed Name of person signing certificate